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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/728,056

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Pascal Arnaud

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22850

7590

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/728,056

Applicant(s)

ARNAUD, PASCAL

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1617

### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted July 11, 2006 is acknowledged.

#### *Claim Rejections 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walling et al (US Pat. 5,948,394) in view of Jakobson et al (US Pat. 5,093,043), and in further view of Arnaud et al. (US 5,961,998).

Walling teaches transfer-resistant lip compositions. The compositions resist transfer upon subjecting the wearer to routine or daily activities. The compositions are in the form of Lipstick (see abstract). The compositions comprise lipophilic materials (30-95 %, which may be wax or oil) and a variety of other components, see, particularly, columns 2, lines 12-25. and claims 1-6.

Walling teaches that a preferred volatile hydrocarbon fluid for use in the invention is isododecane (see col. 4, lines 1-16, and col.6, line 15 through col. 7, Line 45, examples 1-6).

Walling further teaches that a particularly useful non-volatile silicone fluid for use in the invention is available as the 556 series from Dow Corning (see col. 4, line 62 to col. 4, line 9).

DC 556 is a trade name for phenyltrimethicone. Walling further teaches that phenyltrimethicone is a most preferred fluid for the invention (see col. 5, Lines 17-20). Walling teaches that various surfactants may be employed in the composition. Examples 1-6 are further comprised of wax,

Art Unit: 1617

non-volatile oil liquid, isododecane (isoparaffin) and pigments. Additionally, examples 1-4 and 6 contain polyglycerol diisostearate.

Willing does not teach expressly the particular percentages of each ingredient, or expressly states the employment of diglyceryl diisostearate.

However, Jakobson teaches a process for preparing nonionic surfactants. The reference relates to the use of certain nonionic polyglycerol fatty acid ester surfactants as additives or solvents for skin protection agents and skin care oils and for cosmetic formulations (see col. 3, line 47 through col. 4, line 11). Jakobson teaches that diglycerol di-fatty acid esters have improved properties as compared to polyglycerol esters (see col. 4, lines 54-64). Jakobson specifically compares diglycerol diisostearate with commercial polyglycerol diisostearate (see col. 5, lines 17-20). Jakobson further disclosed that commercial polyglycerol diisostearate is essentially diglycerol diisostearate. See column 5, lines 24-28.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a lip cosmetic composition comprising isododecane, phenyltrimethicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited.

A person of ordinary skill in the art would have been motivated to make a lip cosmetic composition comprising isododecane, phenyltrimethicone, and diglycerol diisostearate (such as those disclosed by Jakobson) in a percentage as herein cited because all of the ingredients are known to be useful in lip composition. As to the particular percentage, note where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 105 USPQ 233, 235

Art Unit: 1617

(CCPA 1955). Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the compositions of Walling by the substitution of diglycerol diisostearate for polyglycerol diisostearate as taught by Jakobson in order to benefit from the improved properties of diglycerol diisostearate as taught by Jakobson. One of ordinary skill in the art would have been further motivated to modify Walling's lip composition by incorporating some phenyl trimethicone as oil phase in the particular lip composition since oil with aromatic moiety, such as phenyl trimethicone, are known to provide benefit for lip stick such as increase gloss and reduce migration of oils. See, particularly, column 1, lines 58 to column 2, lines 2, column 6, lines 55-61, the examples and claims of Arnaud et al.

### ***Response to the Arguments***

Applicants' amendments and remarks submitted July 11, 2006 have been fully considered, but are not persuasive.

Applicants contend that Walling merely "generally discloses combining several different types of oils and waxes to form lipstick product," but provide no further guidance to reach the claimed combination, and assert that to reach the particular percentages of each ingredients is not a matter of "optimization. The examiner respectfully disagrees. Note, polyglyceryl diisostearate and phenyl trimethicone are both preferred liquid oils in Walling's lipstick composition. The claimed invention is certainly within the scope of Walling's disclosure. The employment of a mixture of these two oils would have been obvious to one of ordinary skill in the art. It is well settled that "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" *a prima facie case of obviousness exists*. (emphasis added) *In re Wertheim*, 541 F.2d 257, 191 USPQ 90. Further, it has been held that "Generally, differences in concentration or

Art Unit: 1617

temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)." In re Meyer and Akzo v. International Trade Comm'n are misused for the instant case as discussed in the prior office action. In fact, In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). In both In re Meyer and Akzo v. International Trade Comm'n, there were objective evidences of non-obviousness sufficient to rebut the obviousness assumption. In the instant case, applicants' discovery is that for two incompatible non-volatile oil, a volatile oil has to be used. The prior art particularly teach the use of volatile oils, including the preferred volatile oil herein, with the nonvolatile oils. Therefore, whether two non-volatile oils are incompatible without the presence of the volatile oil is not relevant to the issue in the rejection since the prior art teach the employment of volatile oils. See, particularly, col. 4, line10-15 and the examples in Walling et al.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 1617

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG  
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Shengjun Wang  
Primary Examiner  
Art Unit 1617